

REMARKS**ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:**

Applicant(s) request(s) entry of this Rule 116 Response because:

(a) it is believed that the amendment of claims 1, 3-6, 8-10, 12, 14-17, 19-21, 34, 36, and 38 puts this application into condition for allowance as suggested by the Examiner;

(b) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed;

(c) the amendments of claims 1, 3-6, 8-10, 12, 14-17, 19-21, 34, 36, and 38 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and

(d) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. § 102

At page 2 of the Office Action, claims 1-2, and 12-13 were rejected under 35 U.S.C. § 102 as being anticipated by Machihara et al. (USPN 6,233,578).

It appears that the Examiner's understanding of the terminology "standard structure" is different from the meaning of said terminology in the context of the present application. As set forth on lines 25-28 of page 3 of the specification, in the present application descriptors such as "catalog number," "date," "color," "name," "material," "location" and "price" are defined as standard descriptors, typically in string format, and are known on both the query side and the database side for a standard structure. In contrast, the Examiner, under item 2, regards the information resource dictionary included in the information retrieval system of Machihara as a standard structure. It is respectfully submitted that such is not the case. The resource dictionary of Machihara allows the user to specify retrieval conditions and retrieval content using words that are familiar to the user by

converting the requested items entered by the user to related data items. Hence, the resource dictionary provides a reference logic referring to a query structure and a database structure, wherein the requested items entered by the user correspond to the query structure and the data items in the different databases correspond to the database structure. Therefore, the information resource dictionary corresponds to the reference logic defined in claim 1, and not to a standard structure. **A standard structure is not disclosed in Machihara.** Thus, information in Machihara can only be retrieved from the database by previously analyzing the database because the database information is needed for the information resource dictionary. Contrary to Machihara, the method according to claim 1 is based on three structures, namely, a query structure, a database structure and a standard structure, wherein the reference logic provides a link between the query structure and the database structure via a standard structure. Consequently, new databases may be searched by the method according to claim 1 without analyzing the exact content of the databases.

Independent claims 1 and 12 have been amended to show more clearly that the reference logic provides a link between the query structure and the database structure via a standard structure. Thus, amended claims 1 and 12 are now believed to be allowable under 35 U.S.C. § 102 and not anticipated by Machihara et al. (USPN 6,233,578).

Since claims 2 and 13 depend from the amended independent claims, respectively, claims 2 and 13 are submitted to be allowable for at least the reasons that the amended independent claims are allowable rejected under 35 U.S.C. § 102.

Claims 34-38 were rejected under 35 U.S.C. § 102 as being anticipated by Kappenberger et al. (USPN 6,345,269).

Claims 35 and 37 have been cancelled without prejudice or disclaimer. Hence, rejection of claims 35 and 37 under 35 U.S.C. § 102 as being anticipated by Kappenberger et al. (USPN 6,345,269) is now submitted to be moot.

It is respectfully submitted that Kappenberger teaches using an interpreter to receive an inquiry and convert the inquiry into an archive system specific form and execute the inquiry in a selected archive system. Independent claims 34, 36 and 38 have been amended to show more clearly that, in the present invention, the reference logic provides a link between the query structure and the database structure via a standard structure, which is not taught or suggested by Kappenberger. Thus, claims 34, 36 and 38 are submitted to be allowable over Kappenberger under 35 U.S.C. § 102.

REJECTION UNDER 35 U.S.C. § 103

Claims 3-11 and 14-22 were rejected under 35 U.S.C. § 103 as being unpatentable over Machihara et al. (USPN 6,233,578).

These rejections are traversed and reconsideration is requested.

It is respectfully submitted that Machihara et al. fails to teach that the reference logic provides a link between the query structure and the database structure via a standard structure, as is present in the claims of the present invention. The independent claims of the present invention have been amended to show clearly that the reference logic provides a link between the query structure and the database structure via a standard structure. The present invention, as specified in dependent claims 3, 5, 14 and 16, utilizes standard descriptors and special descriptors to facilitate this linkage (line 25 of page 3 through line 2 of page 4):

"As may be seen from this diagram, the descriptors "catalog number," "date," "color," "name," "material," "location" and "price" are defined as standard descriptors GD, typically in string format, and are known on both the query side and the database side.

On the database side, business A, in addition to using these standard descriptors GD, can also use special descriptors HD, such as "purchase date," "season," "description," "stock location," "retail store," and selling price," so that the structure of the database can be optimally adapted to the application."

It is respectfully submitted that the Examiner does not refer to any particular prior art document to provide evidence that it is common knowledge to use standard descriptors as well as more special descriptors to describe the standard structure, the query structure and the database structure. It is respectfully submitted that, if the Examiner submits that such is common knowledge, the Examiner must submit some evidence thereof.

In addition, It is respectfully submitted that the courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Since there is no teaching or suggestion of combining Machihara with standard descriptors or more special descriptors, it is respectfully submitted that claims 3-11 and 14-22 are not obvious and are allowable under 35 U.S.C. § 103 over Machihara et al. (USPN 6,233,578).

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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